

REMARKS/ARGUMENTS

The present communication is responsive to the Office Action mailed February 26, 2008. A Petition for a Three-Month Extension of Time thereby extending the time for responding to the Office Action from May 26, 2008 to and including August 26, 2008 is submitted herewith. A Request for Continued Examination is also submitted herewith.

Claims 1-21 was rejected in the Action. Claims 1 and 21 have been amended. No claims have been added or canceled. Therefore, claims 1-21 remain pending in the present application. Support for amended claims 1 and 21 can be found in Applicants' originally filed specification in at least paragraphs [0104] to [0106]. As such, no new matter has been added. Applicants set forth remarks relating to the Office Action below.

Claims 1, 2, 4, 5, 9-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,478,800 to Fraser et al. ("*Fraser*") in view of U.S. Pat. No. 5,314,477 to Marnay ("*Marnay*"), claim 3 as being unpatentable over *Fraser* in view of *Marnay* in view of U.S. Pat. No. 5,370,697 to Baumgartner, and claim 6-8 as being unpatentable over *Fraser* in view of *Marnay* in view of U.S. Pat. No. 4,566,466 to Ripple et al. ("*Ripple*"). With respect to claim 1, 2, 4, 5, and 9-21 the Examiner asserted that Fig. 1 of *Fraser* shows a tool for implanting a disc in an intervertebral space comprising a shaft 20, two distal extensions 12A, 14A and a pin 20A located between the extensions. Further, the Examiner asserted that Fig. 1 shows a "trial" 24 having two halves located between and engaged with the extensions. The Examiner contends that while *Fraser* fails to teach that the trial halves are separate such that the separation of the extensions move the trial halves, *Marnay*

teaches an insertion tool for separating or applying force to a spinal prosthesis having two halves that can pivot.

Applicants respectfully assert amended claim 1 is not obvious over *Fraser* in view of *Marnay* because the cited references neither disclose nor suggest the configuration of the shaft, distal extensions, and trial halves of the apparatus as claimed. Amended claim 1 requires that the distal extensions coupled to the shaft each have a proximal portion, an intermediate portion and a distal portion, the proximal portions and the distal portions of the extensions having a substantially fixed separation from each other and the intermediate portions of the distal extensions capable of moving toward and separating from one another. This structure is disclosed in at least paragraph [0104] to [0106] of the specification. These paragraphs disclose with respect to the proximal portions of the extensions, the lower distal extension 312b is fixed to the upper distal extension 312a at the fulcrum 311. Further, from the point of division of the extensions at their proximal portions, each of the upper and lower distal extension 312a-b are spring biased toward positions in which they converge toward one another at their distal portions. The distal portions of the extensions are substantially fixed by a pivot pin 315 connected to upper and lower trail halves 306a-b which are connected to the distal portions of extensions 312a-b. Neither *Marnay* nor *Fraser* disclose or suggest the aforementioned required structure of amended claim 1 and therefore cannot be used alone or in combination to obviate claim 1. Claims 2-20 depending therefrom are unobvious, *inter alia*, their dependence from claim 1 which is unobvious for the reasons set forth above.

With respect to claim 21, Applicants respectfully assert that a *prima facie* case of obviousness cannot be made using the cited references. Further, one skilled in the art at

the time the present invention was made would not combine *Fraser* and *Marnay* to arrive at the invention as claimed. The Examiner argues that *Marnay* teaches an insertion tool for separating a prosthesis having two halves that can pivot and asserts that this is the only teaching from *Marnay* that the Examiner intended to convey in the rejection. The Examiner further opines that if the implant capable of pivoting disclosed in *Marnay* is delivered between the extensions of the device disclosed in *Fraser*, the implant would be delivered between adjacent vertebrae while in a pivoted position. Applicants assert that regardless of whether the Examiner's above assertion is true, there is structure required in the claims that is not disclosed or suggested in either of the cited references.

In part, claim 21 recites a bifurcated trial having a first trial half of the bifurcated trial coupled by a first pin to a first of the extensions and having a second trial half of the bifurcated trial fixed to a second of the extensions and a second pin wherein movement of the second pin in a proximal or distal direction causes the first trial half to rotate about the first pin. A *prima facie* case of obviousness cannot with respect to claim 21 cannot be made with the cited references. While the Examiner opined in the Action that "it should also be noted that as the pivoting capability taught by *Marnay* is incorporated into the apparatus of *Fraser* it clearly allows for a varying separation to occur between the upper and lower halves of the implant," neither *Marnay* nor *Fraser* disclose or suggest the aforementioned limitations in amended claim 21. For the foregoing reasons, claim 21 is not obviated by the cited references and is therefore allowable.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is

respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 26, 2008

Respectfully submitted,

By   
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